

REMARKS

Applicant respectfully requests reconsideration for the present application based on the following remarks. Certain informalities have been addressed herein by amendments to Claims 7, 11 and 13. These amendments do not constitute the addition of new matter to the application.

In the office action, Claims 1-16 are provisionally rejected under the judicially created doctrine of double patenting over Claims 1-16 of co-pending U.S. Patent Application Serial Nos. 09/751,287 and 09/751,456. Claims 1-3, 5, 7-9, 11, and 13-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,357,557 to Sakakura in view of U.S. Patent No. 6,035,043 to Sansone et al., in further view of U.S. Patent No. 6,525,657 to Wojcik. Claims 4, 6, 10, 12 and 16 are objected to as being dependent upon a rejected base claim, but are indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant respectfully traverses the claim rejections as follows.

To expedite prosecution of the present application, applicant has submitted two executed "Terminal Disclaimers To Obviate A Provisional Double Patenting Rejection Over A Pending Second Application" with respect to applicant's co-pending U.S. Patent Application Serial Nos. 09/751,287 (Attorney Docket No. 00260), and 09/751,456 (Attorney Docket No. 00349). The terminal disclaimers reference the present application, and copies of the executed terminal disclaimers are enclosed for the examiner's convenient reference. In view of submission of these terminal disclaimers, applicant respectfully requests withdrawal of the provisional double patenting rejection set forth in the office action.

For purposes of various arguments presented herein, applicant invites attention to MPEP §2142, which reads, in pertinent part, as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

....

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986).

In addition, for purposes of various arguments presented herein, applicant invites attention to MPEP §2143.01 entitled, "Suggestion or Motivation To Modify the References" and which reads, in pertinent part, as follows:

THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF  
THE CLAIMED INVENTION

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

FACT THAT REFERENCES CAN BE COMBINED OR  
MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA*  
*FACIE* OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

FACT THAT THE CLAIMED INVENTION IS WITHIN THE  
CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART  
IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA*  
*FACIE* OBVIOUSNESS

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

In addition, for purposes of various arguments presented herein, applicant invites attention to MPEP §2143.03, which is entitled "All Claim Limitations Must Be Taught or Suggested" and which reads, in pertinent part, as follows:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicant submits that the obviousness rejection of Claim 1 is improper for at least the reason that there is no motivation to combine or modify the teachings of the cited references.

Applicant submits that there is no motivation to combine the Sakakura reference and the Wojcik reference. While Sakakura and Wojcik both deal with the topic of wireless telecommunication, each addresses a distinct problem with equipment on a different scale. Sakakura teaches a method for testing call-handling capabilities in a *mobile network*. (See Sakakura at col. 1, ln. 26-58.) On the other hand, Wojcik teaches a method on an entirely different scale. Wojcik teaches measuring the electric field induced in human tissue by an *individual wireless communication device* (i.e. a cell phone). Therefore, Sakakura and Wojcik deal with very different problems, call handling versus RF field emissions, on entirely different scales, mobile networks versus wireless communication devices. Applicant submits therefore that there is no motivation to combine Sakakura and Wojcik, and such an attempted combination would result in at least a partial destruction of the teachings of one or both of the references.

Applicant also submits that there is no motivation to combine Sansone and Wojcik. The two references address entirely different problems. Applicant submits that Sansone discloses, “a cellular telecommunications system that records in the cellular telephone all the telephone calls made by that particular cellular telephone.” (See Sansone at col. 2, ln. 28-30.) On the other hand, as mentioned above, Wojcik teaches measuring the electric field induced in human tissue by an individual wireless communication device. Applicant submits that because these references address distinctly different problems, an attempt to combine the references would result in at least a partial destruction of the teachings of one or both references.

Applicant further submits that the obviousness rejection of Claim 1 is improper because the cited references fail to disclose all of the elements of Claim 1. *See* MPEP § 2142 (a *prima facie* case of obviousness under 35 U.S.C. § 103(a) requires, among other things, that the cited references, when combined, teach or suggest every element of the claim). Applicant submits that none of the cited references discloses, teaches or suggests (collectively herein “discloses”) at least the following features of Claim 1.

- I -

The cited references fail to disclose at least, “performing a second phone call using said Ericsson equipment to perform an RF call trace in connection with said drive test and to obtain a second set of call-specific data,” as recited in Claim 1.

Applicant submits that Sakakura does not disclose at least the above feature of Claim 1. The office action appears to assert that the above feature reads on Sakakura at column 2, lines 60-65. (*See*, Office Action at p. 2.)

The start-point terminal information is the terminal number (dial number) of a terminal serving as a start point in the test. In the embodiment, the start-point terminal information is the dial number of the terminal 31. The next terminal information is the number of a terminal which is to generate a call immediately after a given terminal generates an outgoing call.

(*See*, Sakakura, col. 2, ln. 60-66.) Applicant submits that the cited passage, as well as the rest of the Sakakura reference, fails to disclose, “performing a second phone call using said Ericsson equipment *to perform an RF call trace* in connection with said drive test and to obtain a second set of call-specific data,” as recited in Claim 1 (emphasis added). In fact, it appears that

Sakakura fails to disclose any kind of call trace whatsoever. In addition, applicant submits that neither the Wojcik nor the Sansone reference discloses this feature of Claim 1.

- II -

The cited references also fail to disclose, “combining said first and second sets of data into a combined output file based on respective said time elements of said first and second phone calls,” as recited in Claim 1.

Applicant submits that Sakakura does not disclose this feature of Claim 1. Sakakura discloses an “accumulated test result.” (*See* Sakakura, col. 2, ln. 46-49, col. 3, ln. 25-60.) Applicant submits that Sakakura does not disclose that its accumulated test result is, “combin[ed] . . . based on respective said time elements of said first and second phone calls,” as recited in Claim 1. Applicant submits that the office action does not even assert that Sakakura discloses this element. Rather, the office action states that Sakakura discloses, “combining said first and second sets of data into a combined output file based on respective said elements of said first and said second phone calls.” (*See* Office Action at p. 2-3.) Even if this statement is taken as true, which applicant does not concede, Sakakura still does not disclose, “combining said first and second sets of data into a combined output file based on respective said *time* elements of said first and second phone calls,” as recited in Claim 1 (emphasis added).

Applicant submits that Sansone also fails to disclose at least this feature of Claim 1. The office action states that Sansone discloses, “an element associated with time.” (Office Action at p. 3.) Even if this is taken as true, which applicant does not concede, Sansone still does not disclose, “combining said first and second sets of data into a combined output file based on respective said time elements of said first and second phone calls,” as recited in Claim 1.

Applicant notes that Sansone does disclose, “compar[ing] in block 347 the date, in block 348 the start time and in block 349 the duration of each call for a particular cellular telephone with each UM record.” (See Sansone, col. 9, ln. 21-24.) Applicant submits, however, that this *comparing* of data from a cellular telephone is not, “*combining* said first and second sets of data into a combined output file *based on respective said time elements* of said first and second phone calls,” as recited in Claim 1 (emphasis added).

Applicant further submits that Wojcik fails to disclose this feature of Claim 1.

- III -

In addition, the cited references fail to disclose, “processing said combined output file in a thematic mapping software program to provide a graphical representation of said combined output file,” as recited in Claim 1.

Applicant submits that Wojcik fails to disclose at least the above feature of Claim

1. The office action appears to agree with this statement:

Regarding applicant’s argument that Wojcik fail to disclosed generating a graphical representation of call specific data in a wireless network. The examiner agrees, the examiner, however, contends that the Wojcik reference was solely used to disclose the generating a graphical representation of data that had been inputted or programmed.

(See, Office Action at p. 10.) Even if Wojcik were to disclose, “generating a graphical representation of data that had been inputted or programmed,” which disclosure applicant does not concede, Wojcik still does not disclose, “processing said combined output file in a thematic mapping software program,” or, “to provide a graphical representation *of said combined output file*,” as recited in Claim 1 (emphasis added).

Also, applicant submits that neither Sakakura nor Sansone discloses this feature of Claim 1.

- IV -

For the foregoing reasons, applicant submits that Claim 1, as well as Claims 2-6, which depend from Claim 1, are allowable.

Applicant further submits that Claim 7 is allowable for reasons analogous to those set forth above for Claim 1. Claims 8-12, which depend from Claim 7, are allowable for the same reasons as Claim 7.

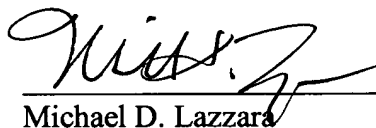
Applicant also submits that Claim 13 is allowable for reasons analogous to those set forth above for Claim 1. Claims 14-16, which depend from Claim 13, are allowable for the same reasons as Claim 13.



SUMMARY

Applicant respectfully requests issuance of a notice of allowance for the pending claims in the present application. The Examiner is invited to contact the undersigned representative by telephone to address any outstanding issues or concerns with the present application.

Respectfully submitted,



Michael D. Lazzara  
Registration No. 41,142  
Attorney for Applicant

KIRKPATRICK & LOCKHART LLP  
Henry W. Oliver Building  
535 Smithfield Street  
Pittsburgh, Pennsylvania 15222-2312

Telephone: (412) 355-8994  
Facsimile: (412) 355-6501  
E-mail: [mlazzara@kl.com](mailto:mlazzara@kl.com)

Customer No. 42779